

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION No.	10/015,816	Group Art Unit:	2173
Applicant(s):	Thomas J. SHAFRON, et al.	Examiner:	Michael Roswell
Filing Date:	November 1, 2001	Docket No.	085804-014301
Title:	Method and System of Facilitating On-Line Shopping Using and Internet Browser	Customer No.	32361

**LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This paper is being filed with a Request for Pre-Appeal Brief Review and Notice of Appeal. Applicant seeks formal review by a panel of Examiners of claim rejections raised in an Office Action mailed November 8, 2006 (hereinafter referred to as "Office Action"). By the Office Action at least one claim stands twice rejected. Accordingly, appeal of the rejection, and request for Pre-Appeal Brief Review are timely and proper.

Remarks begin at page 1 of this paper.

REMARKS

Claims 1 through 14, 16 through 21, 23, 24, 59 and 60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combined references of O'Leary et al., Sidles, and Wiens. Further, Claims 15 and 22 stand rejected as being unpatentable over the above-referenced combination and further in view of a document entitled "Band Objects." Applicant requests review of the aforementioned rejection. The remarks made herein supplement Applicant's remarks of record in the instant case.

Since all claims presently pending involve the O'Leary/Sidles/Wiens combination, the remarks below focus on these three references, since in the absence of propriety of one of the applied references, the rejection under 35 U.S.C. §103(a) will be untenable for all currently pending claims.

Examiner argues that O'Leary and Sidles in combination teach the majority of claim elements but, admittedly, not all. The Examiner has utilized the Wiens reference as allegedly teaching the admittedly missing claim limitation of determination code communicated to or existing at the user's computer for determining if a merchant website is a supported website. The remarks below are directed to the issue of whether or not Wiens does in fact teach or in any way suggest this limitation, since if Wiens cannot be relied upon to supply the element admittedly absent from Sidles and O'Leary, the §103 rejection should be withdrawn.

The claims presently in the case resulted from an Amendment filed with an RCE dated April 17, 2006. This Amendment resulted from a telephonic interview with the Examiner, whereby the claims presented in the April 17th Amendment were deemed to overcome a previous §103 rejection based on the combination of just O'Leary and Sidles. In a subsequent Office Action dated June 22, 2006, the Examiner rejected all pending claims once again, now utilizing

the three reference combination of O'Leary, Sidles and Weins, contending that Weins provides the missing element. A further Response and Final Office Action followed.

Reduced to its essence, the Examiner's argument with respect to the added Weins reference is that since Weins teaches a version control program that communicates a software update to a user's computer if it is determined that the user's computer is not running a current version of a particular off-line order entry program, this equates to downloading computer code that can determine whether a web shopper has navigated to a supported merchant website. While that simple technological leap of itself should be sufficient to point out the deficiencies of Weins, it must be further pointed out that the Weins reference, while generally addressed to ordering articles on-line, is not directed in any way to a determination of whether a particular shopping site is a supported merchant. Rather, Weins teaches a dedicated environment whereby a person desiring to order articles from a website downloads an order entry form from that website that can be completed while the user is off-line. The Weins reference, rather than teaching software code being downloaded and used for determining whether a website is a supported merchant website, teaches code that the shopper uses to fill out a form and then log into a known website to upload the form, with the intended purpose of saving bandwidth.

The Examiner states that "Weins has been shown to teach the providing of computer code to a user's computer to facilitate off-line order entry." Weins, Column 7, lines 28 through 47. In Weins the computer will interrogate the user's computer to determine if it contains the most recent version of order entry software, and if not, it will download the current version. From this, the Examiner has concluded that Weins teaches "the communication of determination code from a vendor's server to a client's computer. A combination of Weins, O'Leary and Sidles would modify the vendor's websites of O'Leary and Sidles to include the determination code of

Weins to ensure that the client always has the ‘pertinent vendor information’ and thus that the vendor is indeed a supported one, and therefore that a vendor website is a supported website.” As an initial matter the term “pertinent vendor information” is not a term that is found in the cited Weins passage, and thus the Examiner has supplied the term “pertinent vendor information” as equating to the determination code as presently claimed. Yet it is clear from the pending claims when read as a whole, and the context of the application presently pending as a whole, that the determination code exists at or is downloaded to the user’s computer in order to determine that a website to which a user navigates is a supported website. This is not in any way the technical equivalent of passing version control software to a user’s computer as is taught by Weins.

There is no dispute in the record that the functions taught by Sidles as allegedly meeting the limitation of the claimed determination code (a point that is itself not conceded but irrelevant in light of the inapplicability of the Weins reference) are performed by proxy servers and are network based. There is no teaching or any suggestion in Sidles, nor has the Examiner pointed out such teaching or suggestion in Sidles, that “determination code” should exist, or determination be performed, at any place other than at the server level. In Sidles the function of filling out order entry forms is performed through a combination of stored information and fuzzy logic which resides at server level intelligence that is unrelated to the user’s browser. There is no teaching or suggestion in Sidles that its proxy server functions could be performed at a user’s computer, as the Examiner contends Weins suggests. Similarly with respect to O’Leary, the Examiner has not relied upon this reference for that limitation nor for communicating such code to a user’s computer or browser.

The Examiner thus utilizes Weins for the sole purpose of identifying a reference that teaches communicating software code from a merchants' website to user's computer. However, the fact that Weins teaches that version control software may be communicated from a server to a user's computer does not in anyway supply the element admittedly missing from the Sidles/O'Leary combination of communicating determination code to the user's computer so that the determination of whether a website is a supported merchant website may be made at the user's computer. Weins simply does not provide the missing element the Examiner has conceded does not exist in the O'Leary/Sidles combination, not does it teach or suggest any such modification of Sidles or O'Leary

Thus, since Weins does not in anyway teach determination code for determining whether a website is a supported merchant website, nor does it teach the communication of such code to a user's computer, Weins cannot form a basis of a satisfactory §103 rejection, since the combination does not yield all of the elements of the independent claims of record, and, accordingly all claim depending therefrom. Weins fails to cure the conceded deficiencies in O'Leary/Sidles, and it is respectfully requested that the §103 rejection based on O'Leary/Sidles and Weins is improper and should be withdrawn.

Further, the undersigned wishes to clarify an argument previously made in connection with Weins teaching away from the three reference combination. The undersigned contends that Weins teaches away from utilizing Weins to motivate a person of skill in the art to modify Sidles and O'Leary, since Weins does not teach or suggest any need for a determination of whether a website is supported or not. This is so because in the Weins system the user only communicates with specific known merchant sites. Thus, to the person of skill, Weins exists in an environment where no determination of a supported merchant needs to be made, since the Weins software

only operates with merchants that are in fact known. The mere fact that version control software is communicated from the merchant to the user's computer does nothing to suggest that the O'Leary/Sidles combination should be modified to incorporate the determination of supported merchants being made at the user's computer. Thus, the undersigned continues to contend that Weins is an inappropriate §103 reference since it teaches away from supplying an admittedly missing claim element.

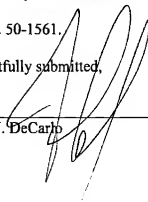
Finally, in connection with Claim 60, the undersigned respectfully urges reconsideration since the record is completely devoid of any teaching or suggestion of the claim limitation of an indicator that signals when the Internet browser is caused to navigate to a supported merchant website. The Examiner has taken Official Notice that indicators of the availability or unavailability of certain functions is known, however with respect to a rejection relying upon Official Notice, it is respectfully submitted that the Official Notice must relate specifically to the feature claimed and it is respectfully requested that the Examiner provide substantiation that it is known in the art to have a shopping assistant button, that has been added to a toolbar of an Internet browser, provide an indicator when the Internet browser is caused to navigate to a supported merchant website.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-1561.

Respectfully submitted,

Date: February 8, 2007

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